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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,308	02/01/2002	David L. Rimm	YUA-001.01	2553

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EXAMINER

MAHATAN, CHANNING

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/062,308

Applicant(s)

RIMM ET AL.

Examiner

Channing S Mahatan

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-32 and 39-43.

Claim(s) withdrawn from consideration: 33-38.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.

10. ☒ Other: _____

C. Mah
December 15, 2004

MPW
MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Continuation of 2. NOTE: Applicants' arguments in filed 23 September 2004 have been considered, however, are found unpersuasive. Applicants are to note that the office action was made final as necessitated by amendment, wherein U.S. Patent Number 6,727,071 was applied under 35 U.S.C. 102(e) and 103(a). Applicants argue Dunlay et al. (U.S. Patent Number 6,727,071) does not teach or suggest the claimed: 1) "method in which the intensity of particular stains is analyzed to actually identify subcellular compartments, such as the cell nucleus or cytoplasm or even virtual compartment"; and 2) the "process for determining if a biomarker is present within a particular subcellular compartment by subtracting a percentage of the intensity value for each pixel location in the second image from the intensity value of the same pixel location in the first image to obtain an adjusted intensity value, indicative of the biomarker within the subcellular compartment". Applicants are directed to the previous office action wherein it was indicated Dunlay et al. teaches "Differences in the average fluorescence intensity in the nucleus sampling region and cytoplasmic sampling region can be calculated, plotted, and displayed (i.e. binned; Column 24, lines 10-31; and Figure 18)". With respect to Applicants arguments for Dunlay et al. (U.S. Patent Number 6,727,071) under 35 U.S.C. 103(a) appear to be missing arguments and reasons by which one of skill in the art would not find obvious to "perform multiple staining, multiple image acquisition, and multiple image analysis for multiple parameter high-content screens", wherein page 11, line 25 of the 'Response' states "The instant claimed method" and nothing further. Applicants have presented additional claims 40-43 without canceling a corresponding number of finally rejected claims. Further, claims 40-43 which presents the new issues of "the cell has been fixed" and "the cell is in tissue" requiring a new search. Therefore, the proposed amendments will not be entered and the rejections in the previous office action, mailed 16 June 2004, are maintained for reasons of record.